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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/634,828

08/06/2003

Tokunori Kato

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06/27/2007

OLIFF & BERRIDGE, PLC

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ALEXANDRIA, VA 22320

EXAMINER

SMITH, CREIGHTON H

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/634,828

Applicant(s)

KATO, TOKUNORI

Examiner

Creighton H. Smith

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 14-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-11 is/are rejected.
- 7) ☒ Claim(s) 12 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

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Applicant's election with traverse of the telephone device of claims 5-13 in the reply filed on 22 MAY '07 is acknowledged. The traversal is on the ground(s) that the office action states that the claims are directed to different species identified as Groups I-IX, and that none of the claims of the non-elected Groups of I and III-IX never specifically exclude the features of Group II. This is not found persuasive because the restriction requirement never says that the claims are species. The office action states that the species of Group I, which include claims 1-5. Of course the claims are not the species, but rather the inventions are the species which are defined by the. Examiner contends that the non-elected claims of groups I & III-IX DO "specifically exclude" the features of elected Group II because if the features have not been claimed, then they have been excluded.

The requirement is still deemed proper and is therefore made FINAL.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's terminology of "audio guidance setting system" and "audio guidance transmitting system" are vague and confusing to examiner. Furthermore, applicant's discussion of these terms in ¶-0014 does not clearly establish what exactly applicant means. Does applicant mean to say that there is a voicemail system within the inventive concept? What element numbers are the audio guidance setting and transmitting system?

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5- 8, 10 are rejected under 35 U.S.C. 102(E) as being anticipated by Shnitzer et al, U.S. patent #7,061,901.

Shnitzer et al show in Fig. 5 a device (85) that may comprise the adapter (120 of Fig. 3), col. 8, lines 4-5. Shnitzer et al invention receives communications from a data network (120). A phone call is directed from the data network (120) via device (85) to phone 100, via physical interface 195 and digital phone switch controller (190). Controller (190) receives the incoming signal and transmits a command signal via interface (200) to processor (180), col. 16, lines 15-25. Shnitzer et al adapter, 12-Fig.1; 42-Fig. 2, allows attachment of a standard phone to a computer as a peripheral. The adapter converts a phone's analog signals to a computer's digital signals and vice-versa - Abstract. As shown in Fig. 3, Shnitzer et al adapter is connected between a PC –16 and a phone 10, just like applicant's MFD-2 is connected between telephone 4 and PC 3.

Therefore, Shnitzer et al shows a telephone (10, 12, **OR** 16-Fig. 3) that will connect to the PSTN-110 via a telephone line (unnumbered but clearly shown connecting the 2 lower phones 10 through PSTN to PC 16 and on to the Internet). Shnitzer's adapter

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has an Internet terminal device controlling system – 190 that will inherently control the control signals from the phone 10/40, switch 150 & col. 16, lines 7-12. The first command input system is shown in Fig. 5 as the keypad on phone 100 and disclosed in col. 11, lines 24 et seq. as a dialed number.

Regarding claim 7, applicant's "terminating command" reads upon a button on the phone that will disconnect the call, or simply by the caller placing the handset into the cradle, i.e., on-hook. For claim 8, see col. 2, line 4; col. 16, lines 9-10. For claim 10, see col. 8, lines 33-39.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shnitzer et al in view of Simpson et al, U.S. Publication #2004/0109409.

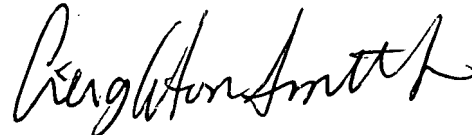
Simpson discloses in her Abstract an Internet call-waiting message. This call-waiting message reads upon applicant's "interruption message." To have provided Simpson et al disclosure of a call-waiting message into Shnitzer et al telephone device would have been obvious to a person having ordinary skill in the art because references are in the area of telephone devices and provisioning and the skilled practitioner would have readily included Simpson's call-waiting message into Shnitzer et al in order to allow the phone's user to be aware of another, possibly very important, incoming call.

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Claims 12 & 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Creighton H.

Smith at telephone number 571/272-7546.

A handwritten signature in black ink, appearing to read "Creighton H. Smith". The signature is fluid and cursive, with the first name being the most prominent.

Creighton H Smith  
Primary Examiner  
Art Unit 2614

19 JUN '07